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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/522,434    03/09/00    KO

F    11544-003001

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HM22/0316

EXAMINER
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COE, S	
ART UNIT	PAPER NUMBER

1651

DATE MAILED:

03/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/522,434

Applicant(s)

KO ET AL.

Examiner

Susan Coe

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2000 and 16 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 4-10 and 12-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☒ Interview Summary (PTO-413) Paper No(s) 7.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### DETAILED ACTION

1. Claims 1-22 are currently pending.

#### *Election/Restrictions*

2. Applicant's election without traverse of group I, claims 1-11 and the extraction procedure of claim 3 (extraction with a solvent having a polarity higher than 0.88) for species A in Paper No. 4, dated December 11, 2000 and Paper No. 7, dated March 14, 2001 is acknowledged.
3. Claims 4-10 and 12-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper Nos. 4 and 7.
4. Claims 1-3 and 11 are examined on the merits.

#### *Claim Objections*

5. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 2 states that the American ginseng is the species *Panax quinquefolium*. According to the related art, American ginseng is the common name for only this species. Therefore, claim 2 does not further limit claim 1.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by CAPLUS English abstract of Japanese Patent No. 62005126 B4.

The claims are drawn to an extract of American ginseng (*Panax quinquefolium*). The composition is effective for treating ulcers.

JP '126 teaches treating ulcers by administering an extract of American ginseng. The ginseng was extracted with methanol. Methanol has a polarity higher than 0.88.

7. Claims 1-3 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by the Derwent English abstract of Chinese Application No. 1079655 A.

CN '655 teaches treating ulcers using a composition containing American ginseng. CN '655 does not specifically teach that the ginseng is extracted; however, claim 3 is considered to be a product-by-process claim. Since the composition taught by CN '655 has the same effects on the body as the extract in the claims, the ginseng of CN '655 must contain the same active ingredients as the extract in the claims. Therefore, the compositions are the same unless a difference between the action of the two can be demonstrated by the applicant.

8. Claims 1-3 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by the Derwent English abstract of Chinese Application No. 1134832 A.

CN '832 teaches using an alcohol extract of American ginseng to treat ulcer.

9. Claims 1-3 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4,795,742.

US '742 teaches administering ginsenosides to treat various health conditions. The ginsenosides are extracted from American ginseng using ethanol (see column 7, Example 1). US '742 does not teach that the ginsenosides treat ulcers; however, due to the fact that the composition of US '742 is the same as the claimed composition, the composition of US '742 would inherently have the same effects on the human body as the claimed composition.

10. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 7:30 to 5:00 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SDC  
March 14, 2001

  
FRANCISCO PRATS  
PRIMARY EXAMINER